

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application of: Stephen J. Brown

Serial No.: 09/237,194

Title: REMOTE HEALTH-MONITORING SYSTEM WITH
NETWORKED SERVER AND HEALTH CARE
PROFESSIONAL

Filed: January 26, 1999

Attorney Docket No.: 99-0120 / 7553.00029

Examiner: Morgan, R.

Art Unit: 3626

In Response To: Decision on Appeal mailed April 20, 2010

REQUEST FOR REHEARING

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

In response to the Decision on Appeal mailed April 20, 2010, please consider the following Request for Rehearing.

GROUND FOR REQUEST

The following request for rehearing is proper under 37 C.F.R. 41.52(a)(1) as pertaining to points believed to have been misapprehended or overlooked in the Decision on Appeal mailed April 20, 2010.

ARGUMENTS

The Board concluded that all of the references, and Kirk in particular, constitute prior art against the instant claims.¹

Appellant will focus on two issues: A) the newly raised question of whether the 07/997,323 application provides a 35 U.S.C. § 112 compliant written description of the invention as recited in the instant claims, which is raised for the first time by the Board,² and B) the Board's analysis of the elements for showing completion of the invention by the Appellant prior to the effective date of the Kirk reference by providing evidence of prior conception of the invention coupled with reasonable diligence beginning prior to the effective reference date until either an actual reduction to practice of the invention or the filing of the patent application.³

Newly Raised Question Under 35 U.S.C. § 112

The Board raises, for the first time, the issue of whether the instant claims are supported by the 1992 disclosure of the 07/997,323 application. The Examiner neither alleged, nor presented

¹ See page 19, lines 18-20 of the Decision on Appeal, mailed April 20, 2010.

² See Finding of Fact 40 on pages 13-14 and lines 4-12 on page 15 of the Decision on Appeal, mailed April 20, 2010.

³ See 37 C.F.R. § 1.131(b) and page 14 et seq. of the Decision on Appeal, mailed April 20, 2010.

arguments challenging either the priority claim of the instant application or the support provided by the 07/997,323 application for the instant claims. The Examiner has stated “The Examiner respectfully submits that the documents submitted by the Applicant indicate that conception of the invention took [place] prior to June 15, 1992.”⁴ The Board raises this issue for the first time without identifying it as a new ground of rejection. If the Board means to raise a new ground of rejection with respect to the priority to which the instant application is entitled, Appellant’s representative respectfully requests that the Board clearly state that a new ground of rejection is being made and afford Appellant the opportunity to reopen prosecution to appropriately respond. Furthermore, if the Board is raising a new ground of rejection, Appellant’s representative respectfully requests the Board provide a clear explanation of the basis for such a rejection. Specifically, the Board has not stated whether the Board has reviewed the 07/997,323 application with respect to supporting the instant claims or is simply citing a lack of response to an issue that has not previously been raised. Appellant’s representative respectfully requests clarification of the Board’s position and, if applicable, an explanation of why the Board considers the Examiner to have erred in not raising such a rejection.

Issues Related to Antedating the Kirk Reference

Appellant’s representative respectfully requests that the Board reconsider the issue of whether Appellant has sustained its burden of showing conception and “reasonable diligence”⁵ in reducing the present invention to practice during the 155 days between Kirk’s filing and the effective filing date of the instant application in light of the following arguments.

⁴ See page 3, section 8 of the final Office Action, mailed August 10, 2007.

⁵ See 37 C.F.R. § 1.131(b).

Conception of the Invention was Prior to Kirk's Filing Date

With respect to the element of conception, the Board appears, at first, to affirm the Examiner's position that the documents submitted by the Appellant indicate that conception of the invention took place prior to June 15, 1992."⁶ Specifically, the Board found that the earliest priority date of Kirk is June 15, 1992 (FF01). The Board stated that it agreed that the declaration under 37 C.F.R. § 1.131 includes evidence of conception prior to Kirk's filing date.⁷ The Board further stated that "the issue reduces to diligence in reducing [the present invention] to practice during the 155 days between Kirk's filing and the effective filing date of the instant application."⁸ Thus, it appears the Board began the analysis by adopting the position taken by the Examiner, that the issue to be resolved was not whether Appellant conceived the present invention prior to Kirk, but rather whether the numerous exhibits submitted by Appellant were sufficient to show "reasonable diligence."

However, the Board then contradicted itself. In particular, the Board states:

"Next, there remains the issue of whether the Appellant invented the claimed subject matter prior to Kirk's filing date. The first issue as regards invention is whether conception occurred prior to Kirk's filing date."

This statement by the Board contradicts the statement made by the Board just two paragraphs previously, where the Board stated that it agreed that the declaration included evidence of conception prior to Kirk's filing date. Appellant respectfully requests that the Board provide a clear unequivocal

⁶ See page 3, section 8 of the final Office Action, mailed August 10, 2007.

⁷ See page 14, line 22 through page 15, line 1 of the Decision on Appeal, mailed April 20, 2010.

⁸ See page 15, lines 1-3 of the Decision on Appeal, dated April 20, 2010.

statement identifying which of the two contradictory positions the Board is taking and an analysis clearly explaining the Board's specific position with respect to conception. Furthermore, Appellant respectfully requests that the Board provide, if applicable, an explanation of why the Board considers the Examiner to have erred in finding that Appellant had met its burden for showing conception prior to Kirk's filing date.

Furthermore, the Board's statement that "There are no details showing the specific components recited in the claim. FF04. Thus [the Board has] no objective evidence that the specific inventions recited in the claims were conceived prior to the applied art," does not appear to take into account the statements presented by the Appellant in paragraph 2 of Appellant's Declaration under 37 C.F.R. § 1.131⁹ specifically laying out the associations between terms used in the attached Exhibits and the claim limitations. Appellant's representative respectfully requests that the Board reconsider its position on this issue taking into account the statements made in paragraph 2 of the declaration.

Evidence of Reasonable Diligence was Submitted by Appellant

With respect to the element of reasonable diligence, proof of reasonable diligence does not require the inventor to work constantly on the invention or to drop all other work.¹⁰ The Board has stated:

"We agree that an inventor does not have to work on reduction to practice every day, if reasonable excuse is provided. 'A review of case law on excuses for inactivity in

⁹ filed September 19, 2006.

¹⁰ *Mycogen Plant Science, Inc., v. Monsanto Co.*, 252 F.3d 1306, 1316, 58 USPQ2d 1891, 1899 (Fed. Cir. 2001), reh'g denied, 261 F.3d 1345, 59 USPQ2d 1852 (Fed. Cir. 2001); see *Bey v. Kollonitsch*, 806 F.2d 1024, 1028, 231 USPQ 967, 970 (Fed. Cir. 1986).

reduction to practice reveals a common thread that courts may consider the reasonable everyday problems and limitations encountered by an inventor.’”¹¹

The Board makes the broad statement that the case law “... is not a general waiver of the requirement for showing that work was performed in the reduction to practice, particularly when the every day [sic] work was done in pursuing commercial development.”¹² However, the Board does not appear to appreciate that the everyday problems and limitations faced by the Appellant necessarily involved commercial matters because during the period from March 2, 1992 to November 17, 1992, Appellant was the Chief Executive Officer (CEO) of a start-up company, Raya Systems, Inc.¹³ In particular, the analysis by the Board of the exhibits presented with Appellant’s Declaration Under 37 C.F.R. § 1.131¹⁴ do not appear to take into account the statements made in paragraphs 9 and 10 of the declaration. Specifically, paragraph 9 states that during the period from March 2, 1992 to November 17, 1992, Appellant was the Chief Executive Officer of a start-up company Raya Systems Inc. Paragraph 10 of the declaration states that during the period from March 2, 1992 to November 17, 1992, Appellant was either working on the present invention or performing other duties as the CEO of the company.

¹¹ See page 16, lines 7-12 of the Decision on Appeal, mailed April 20, 2010, citing *Griffith v. Kanamaru*, 816 F.2d 624, 626 (Fed. Cir. 1987).

¹² See page 16, lines 13-15 of the Decision on Appeal, mailed April 20, 2010, citing *Griffith* at 627 (Fed. Cir. 1987), *quotation omitted*.

¹³ See paragraph 9 of Appellant’s Declaration under 37 C.F.R. §1.131, filed September 19, 2006.

¹⁴ filed September 19, 2006.

The Board makes a point of stating that “[m]any of the activities detailed in the declaration and exhibits bear little relation to actually reducing the invention to practice.”¹⁵ The Board further states:

“Many of the activities are directed to establishing intellectual property protection measures, obtaining speaking engagements, and planning for staffing needs. Others, such as proposing development timetables, are tangentially related, but show no actual reduction itself.”¹⁶

The Board appears to have overlooked the applicability of the activities detailed in the declaration and exhibits as relating to the Appellant’s duties as CEO rather than relating to reduction to practice of the present invention. Appellant’s representative respectfully requests that the Board reconsider the activities detailed in the declaration and exhibits which relate to the Appellant’s duties as CEO and, therefore, provide reasonable excuses for inactivity in reduction to practice during the corresponding periods.

The activities that the Board points out as not supporting diligence because they bear little direct relation to actually reducing the invention to practice are provided as evidence of activities which the Appellant had to perform as CEO of a start-up company. Again, the inventor need not work on reduction to practice every day if reasonable excuse is provided. Here the Appellant, as the Chief Executive Officer, in order to bring a start-up company to successful operation and a chance at survival, had to perform activities in order to keep the company viable. Those activities are presented in the exhibits attached to the Appellant’s declaration which the Board refers to as establishing intellectual property protection measures, obtaining speaking engagements and planning

¹⁵ See page 16, lines 22-24 of the Decision on Appeal, mailed April 20, 2010.

¹⁶ See page 16, lines 24-27 of the Decision on Appeal, mailed April 20, 2010.

for staffing meetings. These exhibits were not presented to support activities toward the reduction to practice, but rather were presented as evidence of activities which Appellant engaged in as CEO, and which prevented him from working on the invention. The exhibits provide evidence of a reasonable excuse for not having worked on the invention. Appellant' representative respectfully requests that the Board reconsider its analysis of these particular exhibits in light of the fact that they were meant to show activities which Appellant had to engage in as the Chief Executive Officer of a start-up company, not as activities engaged in the reduction to practice of the presently claimed invention and, therefore, provide reasonable excuse for not having performed activities towards the reduction to practice of the present invention.

Furthermore, not all commercial activity is prohibited from consideration as evidence of reasonable diligence. Specifically, in *Scott v. Koyama*¹⁷ the Federal Circuit found that the PTO Board erred in holding that a junior party's activities during a 17-day critical period directed toward building a commercial scale plant to carry out a process did not constitute diligence toward reduction to practice of the process. The Federal Circuit distinguished the activity of building the plant stating that the junior party "was proceeding diligently to manufacture by building a plant designed to practice the process of the count, whereas the cases where diligence was not found show inventors either discontinuing development or failing to complete the invention while pursuing financing or other commercial activity." Appellant did not discontinue development and did not fail to complete the invention while engaged in performing his everyday duties as CEO of Raya Systems, Inc. In particular, as CEO Appellant oversaw the employment of Jack Thornton as Director of Product Development in June 1992, whose work included working on the specifications for the present

¹⁷ 281 F.3d 1243 (Fed. Cir. 2002).

invention.¹⁸ The Board has not cited any evidence on the record that contradicts Appellant's statements that Jack Thornton was hired to perform and engaged in activities directed toward the reduction to practice of the present invention. For the reasons presented above, Appellant's representative respectfully requests that the Board reconsider the activities detailed in the declaration and exhibits as relating to the Appellant's duties as CEO and, therefore, providing reasonable excuses for inactivity by the Appellant in reduction to practice during the corresponding periods. Appellant's representative respectfully requests that the Board also reconsider the statements relating to Jack Thornton as relating to activities by others directed to reducing the present invention to practice and attributable to the Appellant through the employee relationship.

The Board makes broad statements in the findings of fact FF10, FF13 and FF14 that phrases referred to in the exhibits do not occur in the claims. However, paragraph 2 of Appellant's Declaration Under 37 C.F.R. § 1.131¹⁹ identifies how the terms found in the exhibits correspond (relate) to the specific limitations recited in the claims. Thus paragraph 2 of the declaration provides a mapping between the exhibits and the present claims which the Board appears to have overlooked. In particular, finding of fact FF10 states:

"Exhibit G is a letter laying out a proposed development timetable for Camit 2.5. Declaration paragraph 19 states that this corresponds to the provider interface. The phase provider interface occurs in none of the claims. Numerous proposed generic activities

¹⁸ See paragraph 29 of Appellant's Declaration under 37 C.F.R. §1.131, filed September 19, 2006.

¹⁹ filed September 19, 2006.

are listed. None of which pertain to specific claim limitations. No specific details of development activities of the claim subject matter are provided.”

Paragraph 2 of the declaration states that a healthcare provider computer recited in the claims corresponds to the provider interface.²⁰

The finding of fact FF13 states:

“Exhibit J is a letter describing personnel assignments and hiring decisions. Declaration paragraph 22 states that this includes a development status report. No discernable description of the inventions development status is present except for a statement as to the need to start on Camit 2.5 and Diabcare documentation. The letter provides no translation from these names to the specific claim limitations. Therefore, how this letter relates to the need for documentation as to the claim subject matter is not provided. No specific details of the development activities of the claim subject matter are provided.”

Paragraph 2 of the declaration state that documents related to Diabcare relate to development of the database element of the presently pending claims and that documents relating to Camit software relate to the development of the provider interface. Paragraph 2 of the declaration further associates the provider interface with a health care provider computer. The health care provider computer term reasonably corresponds to the term health care professional computer appearing in the instant claims.

The finding of fact FF14 states:

“Exhibit K is a one page bullet list of introductions, Raya system status, organization and administrative issues. Declaration paragraph 23 states that this was a meeting agenda

²⁰ Paragraph 2, lines 4-5 of Appellant's Declaration Under 37 C.F.R. § 1.131, filed September 19, 2006.

that listed the Nintendo project related to the patient interface portion of the invention. Nothing in the agenda provides any details as to what was to be actually discussed. The phrase ‘patient interface’ occurs in none of the claims. No specific details of development activities of the claimed subject matter are provided. The agenda is dated prior to Kirk’s filing date.”

Paragraph 14 of the declaration states that a preliminary design document for KinderCamit was generated as shown by the copy of the design document attached as Exhibit D. The Kindercamit document relates to development of the patient interface portion of the present invention. Paragraph 2 of the declaration associates references to the blood glucose meter and the project CamiTEL, the project Nintendo, and the project KinderCamit software as being related to the patient interface element of the instant claims. Paragraph 2 also relates the phrase “remote patient sites” with the term “patient interface.” Thus, the declaration provides the correspondence between the exhibits and the instant claim language.

In forming conclusions regarding the findings of fact, the Board does not appear to have taken paragraph 2 of Appellant’s Declaration under 37 C.F.R. § 1.131²¹ into consideration when looking at the specific claim limitations and terms used in the exhibits. As such, the Board’s conclusions that the language used does not appear in the claims and therefore the exhibits do not appear to be relevant to the claim language does not appear to be proper. Appellant’s representative respectfully requests that the Board reconsider the findings of facts in light of the statements made in paragraph 2 of Appellant’s Declaration Under 37 C.F.R. § 1.131.²²

²¹ filed September 19, 2006.

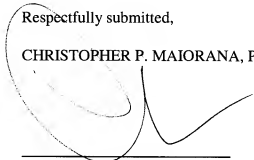
²² filed September 19, 2006.

For the reasons presented above, Appellant respectfully requests that the Board reconsider that Kirk does not constitute proper prior art against the instant claims in light of Appellant's Declaration under 37 C.F.R. §1.131, filed September 19, 2006 and the arguments presented above. Appellant respectfully requests that the Board also reconsider the arguments presented in the Appeal Brief, filed March 31, 2008, in light of the arguments presented above.

If any additional fees are due, please charge Deposit Account No. 50-0541.

Respectfully submitted,

CHRISTOPHER P. MAIORANA, P.C.



Christopher P. Maiorana
Registration No. 42,829

Dated: June 21, 2010

c/o Sandeep Jaggi
Health Hero Network

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